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EXAMINER FOREMAN, JONATHAN M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/882,363

Applicant(s)

ALEXANDER ET AL.

Examiner

JONATHAN ML FOREMAN

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/22/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 69-72 and 75-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 69-72 and 75-89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 69, 70, 75 – 81 and 84 – 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,682,886 to Delp et al. in view of U.S. Patent No. 5,895,428 to Berry.

In regard to claims 69, 70, 75 – 81 and 84 – 89, Delp et al. disclose obtaining an electronic image of a joint (Col. 8, lines 33 – 61), wherein the image includes both normal and diseased cartilage tissue; electronically evaluating the image to obtain information including at least one of volume, area, thickness, shape, curvature geometry, biochemical contents, signal intensity and relaxation time of the normal and/or diseased tissue; and determining biomechanical data associated with the joint (Col. 8, line 63 – Col. 10 - 53). The biomechanical data includes at least one axis associated with the joint, the at least one axis associated with a femoral condyle coordinate system and including one of a medial-lateral axis, an inferior-superior axis, and an anterior-posterior axis (Col. 11, lines 49 – 51). The biomechanical data includes at least one axis associated with the joint, the at least one axis associated with a tibial coordinate system and including one of a medial-lateral axis, an inferior-superior axis, and an anterior-posterior axis (Col. 11, lines 49 – 51). The biomechanical data includes static loading alignment in that the data is determined during a static loading position. The data is displayed. Delp et al. disclose using the information to choose an implant (Col. 12, line 63 – Col. 14, line 63) for use in therapy. However, Delp et al. fail to disclose

shaping an implant based on the information from the imaging. Berry discloses using information received from imaging to shape an implant (Col. 3, lines 9 - 12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use information obtained during imaging to shape an implant as taught by Berry in order to enable rapid final sculpting of a highly customized implant (Col. 3, lines 9 - 12).

3. Claims 69, 70, 71, 76, 80, 81, 82 and 86 rejected under 35 U.S.C. 103(a) as being unpatentable over by Kshirsager et al. (Investigative Radiology, vol. 33, no. 5) in view of U.S. Patent No. 5,682,886 to Delp et al. and U.S. Patent No. 5,895,428 to Berry.

In regard to claims 69, 70, 71, 76, 80, 81, 82 and 86, Kshirsager et al. disclose obtaining an electronic image of a joint, wherein the image includes both normal and diseased cartilage tissue; electronically evaluating the image to obtain information including at least one of volume, area, thickness, shape, curvature geometry, biochemical contents, signal intensity and relaxation time of the normal and/or diseased tissue; and determining biomechanical data associated with the joint (Page 290, "Image Processing"). The biomechanical data includes static loading alignment in that the data is determined during a static loading position. Kshirsager et al. teach determining biomechanical data during joint motion (Page 298, Col. 1). The data is displayed. However, Kshirsager et al. fail to teach the biomechanical data includes at least one axis associated with the joint, the at least one axis associated with a femoral condyle coordinate system or a tibial coordinate system and including one of a medial-lateral axis, an inferior-superior axis, and an anterior-posterior axis. However, Delp et al. teach a method of obtaining an electronic image of the joint and determining at least one axis associated with a femoral condyle coordinate system or a tibial coordinate system and including one of a medial-lateral axis, an inferior-superior axis, and an anterior-posterior axis (Col. 11, lines 49 - 51). It would have been obvious to one having ordinary

skill in the art at the time the invention was made to modify the method disclosed by Kshirsager et al. to include the determining of at least one axis as taught by Delp et al. in order to create a better 3d model of the joint and to better diagnose the joint. Furthermore, the claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the technique of determining at least one axis as taught by Delp et al. to improve the method of Kshirsager et al. for the predictable result of creating a 3d image having correct anatomical relationships. Kshirsager et al. in view of Delp et al. disclose the data being derived from a degenerative knee by an MRI but fail to disclose using the data to provide a therapy in the form of shaping an implant. Berry discloses using data received from an MRI to shape an implant (Col. 3, lines 9 - 12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use information obtained during an MRI to shape an implant as taught by Berry in order to enable rapid final sculpting of a highly customized implant (Col. 3, lines 9 - 12).

In regard to claims 72 and 83, Kshirsager et al. in view of Delp et al. and Berry teach determining data during joint motion, but fail to disclose the joint motion being during a patient's gait. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as disclosed by Kshirsager et al. in view of Delp et al. to determine data during a gait cycle of a patient in order to analyze the patient during a typical unconstrained movement.

4. Claims 69, 70, 76, 80, 81 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,560,476 to Pelletier et al. in view of U.S. Patent No. 5,682,886 to Delp et al. and U.S. Patent No. 5,895,428 to Berry.

In regard to claims 69, 70, 76, 80, 81 and 86, Pelletier et al. disclose obtaining an electronic image of a joint, wherein the image includes both normal and diseased cartilage tissue; electronically evaluating the image to obtain information including at least one of volume, area, thickness, shape, curvature geometry, biochemical contents, signal intensity and relaxation time of the normal and/or diseased tissue; and determining biomechanical data associated with the joint (Col. 9, lines 48 – 51; Col. 12, lines 46 – 56). The biomechanical data includes static loading alignment in that the data is determined during a static loading position. The data is displayed. Pelletier et al. fail to teach the biomechanical data includes at least one axis associated with the joint, the at least one axis associated with a femoral condyle coordinate system or a tibial coordinate system and including one of a medial-lateral axis, an inferior-superior axis, and an anterior-posterior axis. However, Delp et al. teach a method of obtaining an electronic image of the joint and determining at least one axis associated with a femoral condyle coordinate system or a tibial coordinate system and including one of a medial-lateral axis, an inferior-superior axis, and an anterior-posterior axis (Col. 11, lines 49 – 51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method disclosed by Pelletier et al. to include the determining of at least one axis as taught by Delp et al. in order to create a better 3d model of the joint and to better diagnose the joint. Furthermore, the claim would have been obvious because a particular known technique was recognizes as part of the ordinary capabilities of one skilled in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the technique of determining at least one axis as taught by Delp et al. to improve the method of Pelletier et al. for the predictable result of creating a 3d image having correct anatomical relationships. Pelletier et al. in view of Delp et al. disclose the data being derived from a degenerative knee by an MRI but fail to disclose using the data to provide a therapy in the form of shaping an implant. Berry discloses using

data received from an MRI to shape an implant (Col. 3, lines 9 - 12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use information obtained during an MRI to shape an implant as taught by Berry in order to enable rapid final sculpting of a highly customized implant (Col. 3, lines 9 - 12).

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736